

and more particularly, the compound having said formula wherein the bonds depicted as wavy bonds represent the 7aS,6S isomer, which is Example 5.

Claims 23-41 each read on this elected species. Applicant understands this is a provisional election for purposes of search and examination only, in accordance with MPEP § 803.02, and not a requirement to restrict the scope of the generic and subgeneric claims of this application to such species. Applicant understands that, if the elected species is found to be allowable, applicant's claims covering other disclosed species will be considered and examined, since applicant is entitled to consideration of claims to a reasonable number of species in addition to the elected species as provided for under 37 CFR 1.146.

Additionally, applicant traverses the restriction requirement set forth in the Office Action mailed September 13, 2002, for the following reasons.

In a chemical case such as this, the Markush practice allows the applicant to claim a reasonable number of alternative selections for various substituents. In this vein, MPEP § 803.02 is pertinent, which states:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner ... will not require restriction.

The compounds exemplified in the specification were tested and demonstrated activity as LFA-1/ICAM inhibitors. The claimed compounds share many common features such that a search and examination of these compounds should not be unduly burdensome.

Notably, MPEP § 803.01 further instructs that:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Applicant thus traverses the restriction requirement. A search directed to compounds covered by the claims can be performed, without serious burden, beyond those specific groups recited in the Office Action. Applicant respectfully submits, for example, that it should not be unduly burdensome to expand the scope of the search and examination to compounds where L and K can be O or S; and/or to compounds where T can be N or CH, and/or to compounds where Y can be N or CH, regardless of whether these are considered patentably distinct inventions, which applicant does not dispute.

Nonetheless, to expedite prosecution, applicant has canceled claims 1-10, 12, and 14-22, without prejudice, and added new claims 23 –41. Each of the new claims recite compounds where where r and s are both 1 (five membered rings are recited); T is a carbon atom; Y is CH; M is N; L and K are both O; and Q is the group -W-(CH₂)_m-, wherein W is selected from -O-, -NR₁₀-, -S-, -C(=O)-, -CO₂-, and -CH₂- and m is 0, 1, 2, 3 or 4. In more narrow claims (e.g., claim 25), W is selected from O, S and -NR₁₀-, wherein R₁₀ is defined in accordance with the examples. Applicant respectfully notes that if Q were restricted to just O, S, or N, Applicant's elected species of Example 5, as well as many other compounds exemplified in the specification, would not be covered, because in Example 5 and other examples, m is greater than 0. Applicant does not contend that the various Q groups are interchangeable and not patentably distinct; applicant submits they are patentably distinct but that a search and examination can be performed as to these groups. Applicant reserves the right to present claims in one or more divisional applications to compounds where r and

s are other than 1; where T is N; where Y is N; where M is CH; where L and K are sulfur; and where Q is other than as claimed herein.

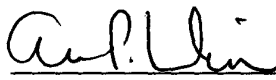
Applicant requests that a full search and examination be performed with regard to all claims now pending. No new matter is introduced by new claims 23-41. Rather, these claims are substantially co-extensive in scope with the original claims, except as to omit the groups, as noted above, that were subject to the restriction requirement (e.g., claim 29 corresponds to original claim 9.)

No fees should be due. However, if it is determined that a fee is due, please charge same to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

Applicant requests that the Examiner contact the undersigned if it is believed this would expedite the search and examination of this case.

Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000
609-252-3342
Date: December 13, 2002


Anastasia P. Winslow
Attorney for Applicants
Reg. No. 40,875